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In the Supreme Court of the United States

OCTOBER TERM, 1964

No. 265

GIUSEPPE BRANDANO ET AL.,
PETITIONERS,

v.

STANLEY L. HANDMAN ET AL.,
RESPONDENTS.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

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Petitioners, Giuseppe Brandano and G. Brandano & Sons Co., Inc., pray that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the First Circuit in the above-entitled case.

Opinions Below

The one sentence opinion of the Court of Appeals is reprinted in the Appendix, page 10 infra. The opinion of the District Court for the District of Massachusetts is

reported at 232 F. Supp. 427 and is reprinted in the printed record (R49-59)[1]

Jurisdiction

The judgment of the Court of Appeals was entered on March 9, 1965, (Appendix page 11 infra). A timely petition for rehearing was denied on March 24, 1965. (Appendix page 12 infra). The jurisdiction of this Court is invoked pursuant to 28 USC 1254(1). The basis of jurisdiction in the District Court was 28 USC 1338.

Introductory Statement

This Court has decided to review the standard of patentability in several pending petitions, all dealing with small improvements in well developed arts.[2] The present case concerns a pioneer and economically important invention —the first reliable and safe pool for live storage of lobsters in restaurants, markets and other locations away from the ocean.

Questions Presented

1. Is it not improper to invalidate a patent by combining and rearranging selected parts from two *unsatisfactory*

[1] The record references are to the two volume printed record prepared for the Court of Appeals. Volume 1, (pages 1-66) contains the pleadings, judgment and testimony printed for the Court of Appeals. Volume 2 (pages 67-96), contains the exhibits submitted to the Court of Appeals, including the various patents involved, as well as pages 97-102 of the record printed by the appellees. We have filed nine copies of this record with this petition.

[2] Pending petitions 778 and 810 (*Calmar Inc.* v. *Cook Chemical Company* and *Colgate-Palmolive Company* v. *Cook Chemical Company*) relate to a new cap for an insecticide spray can. Pending petition 580 (*William T. Graham et al* v. *John Deere Company of Kansas City et al*) relates to a plow of improved shock resistance. Petition 906 (*United States of America* v. *Bert N. Adams et al*) relates to a battery with different electrodes.

prior devices, particularly where one device had already been considered and discarded by the Patent Office?

2. Has not the Court of Appeals in effect denied petitioners their right of review by affirming without *any* explanation the District Court judgment of invalidity, particularly where the District Court had found piratical infringement and where the appellants had raised and briefed an important question of law relating to validity?

Constitutional and Statutory Provisions Involved

This case involves Clause 8 of Section 8, Article 1 of the Constitution of the United States, Sections 101, 102, 103 and 282 of Title 35 and Section 1291 of Title 28 of the United States Code. These provisions are set forth in the Appendix beginning at page 7 infra.

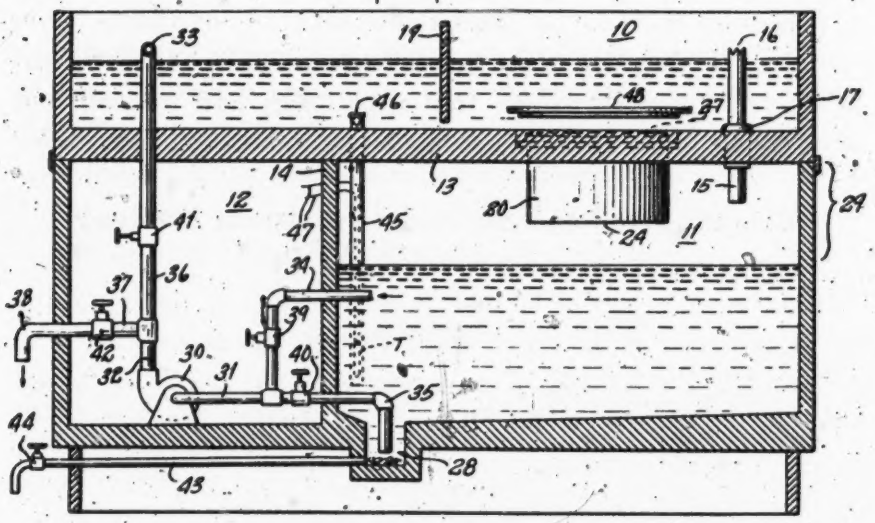
Statement of the Facts

The patent in suit is that of Giuseppe Brandano, plaintiff, U.S. 2,981,228, and is entitled "DISPLAY TANK FOR SHELLFISH". It describes a tank which solves the difficult problem of storing and maintaining lobsters in a healthy condition away from the ocean. (R67-71).

As stated by the District Court in its opinion, the patented tank consists of an upper compartment for storage and display of live lobsters and two lower compartments, one used as a reservoir for the brine and the other containing the conventional refrigerating equipment and a pump for pumping the water from the reservoir compartment to the upper compartment (R51). [Please refer to Fig 2 of the patent (R67) (which is reproduced on page 4) which shows the relationship between the three compartments and clearly indicates the important feature of the *accessible* replaceable filter 20 positioned through the bottom of the

upper compartment 10 and penetrating into an air space above the brine level in the lower or reservoir tank 11.]

Fig. 2.



This filter permits the water to flow from the upper compartment through the filter into the lower reservoir compartment. As pointed out by the District Court "The filtering element in the filter box prevents lobster excrement and other residue from falling into the reservoir and being carried to the pump." (R51) The reservoir is sufficiently larger* and the rate of flow so regulated that there is an *air space* maintained above the water level of the reservoir. Water dropping through the filter box is not only filtered and separated from the excrement but is aerated before joining the body of water in the reservoir. (R51-52)

In its Findings of Fact 7, 8 and 9 (R53), the District Court found that the defendants had deliberately copied the Brandano pool and its its Conclusion of Law 1 (R57-58) found infringement to exist if the patent were valid.

*Large enough so that water in 10 can be quickly dumped into 11 by stopping pump 30 and removing pipe 16 thus permitting replacement of filter element without changing water or harming lobsters.

Plaintiff Brandano's patent (R67) was the *first* to solve the problem of how to effectively keep a lobster tank free of excretion and yet provide the lobsters with cool oxygenated brine. The crucial contribution made by Brandano after long experimentation was to have the floor of the top or display compartment be the ceiling of the bottom compartment and have a filter extend through the ceiling to an air space above the brine level in the lower compartment. None of the prior art tanks were satisfactory, nor did they show the arrangement of the patent in suit. The prior patent relied on by the Court, namely McGrath (R75-82), was cited by the Patent Office during the prosecution of the patent but then discarded because of its critical omission of an air space. (R87-96) The other prior art reference, the Marden pool, was established solely by the oral testimony of one witness who admitted that it did not operate very well and that after the patent in suit had issued he substituted a through-ceiling filter like the one in the patent. (R44)

Reasons for Granting the Writ

1. The discretionary power of this Court to grant a Writ of Certiorari is invoked on the ground that the decision of the United States Court of Appeals for the First Circuit is a decision involving patentability which is contrary to the standard set forth in 35 USC 101, 102 and 103. The standard of patentability is an important question which has not been, but should be settled by this Court. At present, Petition numbers 580, 778, 810 and 906, referred to previously, have all been granted and are awaiting further proceedings in this Court. All of these prior petitions involve primarily the same statutory sections but only as applied to relatively narrow improvements in their respective arts. For full consideration of these important sections

of the patent statute, this Court should grant review in the present case, which involves a pioneer contribution to a sparse art rather than a minor contribution to a crowded art. Consideration of this present case in conjunction with the other above-mentioned cases should enable the Court to provide comprehensive guidance to the District Courts and Courts of Appeals in Federal cases involving this important question of the standard of patentability.

2. A further reason for this Court to grant this writ is that this Court should exercise its supervisory power to insure that a litigant is provided with the legal benefits to which he is entitled in United States courts. Although the District Court made detailed findings of fact and conclusions of law, the Court of Appeals for the First Circuit composed of one permanent and two temporary members, did not give any reason for its affirmance. This occurred in spite of the full briefing and hearing before the Court of Appeals of the important question of application of the proper standard of invention. The Court of Appeals has thus not given due consideration to the contentions of the appellants and has in effect deprived them of their right of review.

Conclusion

For the reasons stated, this Petition for Certiorari should be granted.

Respectfully submitted,

JOSEPH ZALLEN
6 Beacon Street
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June, 1965

Appendix A

Constitutional and Statutory Provisions

1. Article I, Section 8, Clause 8, of the Constitution provides:

The Congress shall have Power . . .

. . .

To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . .

2. Sections 101, 102 and 103 of the Patent Code of 1952 provide (35 U.S.C. §§ 101-03):

§ 101. *Inventions patentable*

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

§ 102. *Conditions for patentability; novelty and loss of right to patent*

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country more

than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

§ 103. *Conditions for patentability; non-obvious subject matter*

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time

the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Section 1291 of Title 28:

§ 1291. *Final decisions of district courts*

The courts of appeals shall have jurisdiction of appeals from all final decisions of the district courts of the United States, the United States District Court for the District of the Canal Zone, the District Court of Guam and the District Court of the Virgin Islands, except where a direct review may be had in the Supreme Court.

Appendix B

United States Court of Appeals
For the First Circuit

No. 6430.

GIUSEPPE BRANDANO ET AL.,
PLAINTIFFS, APPELLANTS,
v.
STANLEY L. HANDMAN ET AL.,
DEFENDANTS, APPELLEES.

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

[232 F. Supp. 427]

Before ALDRICH, *Chief Judge*, WATERMAN,* *Circuit Judge*, and GIGNOUX, *District Judge*.

Joseph Zallen for appellants.
Arthur D. Thompson, with whom *Robert G. Kline* was on brief, for appellees.

OPINION OF THE COURT.
March 9, 1965.

PER CURIAM. *The judgment of the District Court is affirmed.*

*Sitting by designation.

Appendix C

United States Court of Appeals
For the First Circuit

No. 6430.

GIUSEPPE BRANDANO ET AL.,
PLAINTIFFS, APPELLANTS,

v.

STANLEY L. HANDMAN ET AL.,
DEFENDANTS, APPELLEES.

JUDGMENT
March 9, 1965.

This cause came on to be heard on appeal from the United States District Court for the District of Massachusetts, and was argued by counsel.

Upon consideration whereof, It is now here ordered, adjudged and decreed as follows: The judgment of the District Court is affirmed.

By the Court:
(s) ROGER A. STINCHFIELD
Clerk.

[cc. Messrs. Zallen and Thomson.]

Appendix D

United States Court of Appeals
For the First Circuit

No. 6430.

GIUSEPPE BRANDANO ET AL.,
PLAINTIFFS, APPELLANTS,

v.

STANLEY L. HANDMAN ET AL.,
DEFENDANTS, APPELLEES.

ORDER OF THE COURT
March 24, 1965

It is ordered that the petition for rehearing filed March 22, 1965, be, and the same hereby is, denied.

By the Court:

(s) ROGER A. STINCHFIELD,
Clerk.

[cc. Messrs. Zallen and Thomson.]